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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,001	05/10/2001	Momoe Kawajiri	1248-0541P	4123

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EXAMINER

HUYNH, SON P

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/852,001	<b>Applicant(s)</b> KAWAJIRI, MOMOE	
	<b>Examiner</b> Son P. Huynh	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 2-4, 6 are objected to because of the following informalities:

The limitation “the data recording medium” in claims 2 and 4, line 1 or the limitation “the data recording means” in claim 6, line 1, should be replaced as – **the data recording device—**

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether claims 19-30 claim an entrance ticket for performance used at a portable device in a performance recording system or the performance recording system.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US 2005/0028208).

Regarding claim 1, Ellis discloses a data recording device (program guide equipment 17 including program guide server, digital storage device, secondary storage device, storage 56, VCR – figures 1, 2b, 3-5), comprising:

receiving means for receiving data distributed through a distribution medium (e.g., control circuit 42 or receiving device at the video distribution facility for receiving program and program guide data distributed through a distribution medium 18 – see including, but are not limited to, figures 1, 4-5, paragraphs 0066-0067, 0080, 0083);

Ellis further discloses the user using remote access device 24 to select a program for recording, the information of the selected program (i.e. program identifier,

Art Unit: 2623

title, etc.) is stored in storage device (i.e. storage 56 – figure 5, or digital storage device – figure 4), at an appropriate time, the selected program is recorded in determined storage device such as digital storage device, secondary storage device, or storage 56 or program guide server (see including, but are not limited to, paragraphs 0127-0128, 0163-0164. Also see reference 2003/0149988 –hereinafter referred to as '988, paragraphs 0060, 0082, 0087, which is incorporated by reference in its entirety – paragraph 0017). Therefore, the recording device inherently comprises a comparing means for making a comparison between a data identifier included in the data received by the receiving means (i.e. program identifier, program title, etc. receiving through the program source such as main facility) and a data identifier inputted from the outside (e.g. data inputted by the user using remote access device 24); and storing means (i.e., digital storage device, secondary storage device, storage 56, or program guide server) for storing data having the data identifier (program with selected title, program identifier, etc.) when the two data identifiers coincide with each other so that the selected program is recorded in storage device when the selected program is aired.

Regarding claim 2, Ellis further discloses the data recording device further comprising:

accepting means (i.e. communications device 27 – figure 2d, or communications device 37 – figure 3) for accepting from a portable device which stores a data identifier and is set to be ready to communicate data with the data recording device, the data identifier as the data identifier inputted from the outside (communications device (27 or 37) accepts from the remote access device 24 which stores a data identifier in storage

Art Unit: 2623

56 and is set to be ready to communicate data with the program guide equipment 17, the data identifier as identifier (i.e. identifier of program to be recorded, to be watched, etc.) inputted from the outside (e.g. using user interface 52 –figure 5, paragraphs 0072, 0086, 0093, 0103, 0107, 0127-0129, 0134, 0163).

Regarding claim 3, Ellis further discloses the data recording device further comprising: data reproducing for reproducing data which are read out of the storage device (e.g. control circuit 42 or processing circuitry 54 for retrieving the stored data from the storage device for playback on the display device – see including, but is not limited to, figures 4-5);

wherein when referring to data stored in the storing means and detecting stored data corresponding to the data identifier from the accepting means, the comparing means reads the data out of the storing means to the data reproducing means, and when the data are not yet stored in the storing means (i.e. determining whether the portion of the program has already been cached – see “988, paragraph 0197), the comparing means compares a data identifier which is included in the data received by the receiving means with a data identifier from the portable device (remote access device 24), and the storing means stores data having the corresponding data identifier according to results of the comparison (see including, but are not limited to, figures 3-5, paragraphs 0082, 0103, 0107, 0115, 0127 and “988, paragraphs 0187, 0126, 0149, 0153, 0157, 0187, 0197).

Art Unit: 2623

Regarding claim 4, Ellis further discloses wherein a data identifier to be accepted by the accepting means includes a partial data identifier (i.e. identifier of an episode/segment of program series) for identifying partial data included in the data, and the storing means reads out the corresponding partial data to the data reproducing means when the partial data identifier is accepted (storing means reads out requested episode/segment for playback – see including, but are not limited to, paragraphs 0017, 0128-0129; “988, paragraphs 0177-0180).

Regarding claim 5, Ellis further discloses the data recording device further comprising:

data reproducing means for reproducing data read out of the storing means (control circuitry or processing circuitry for reproducing data read out of the storing device for playing back on the display device – figures 4-5; “988, paragraphs 0153, 0157);

displaying means for displaying an icon which corresponds to the data identifier accepted by the accepting means (i.e. displaying device for displaying icon corresponds to the program/recorded program that allow user to select the program to playback- see including, but are not limited to, figures 7-11, paragraphs 0110, 0170; ‘988, figures 18a-21);

input means for selectively inputting the icon displayed by the display means (e.g. remote control device or remote access device for selecting the icon on the display device – see including, but are not limited to, figures 4-10, “988, figures 18a-21);

Art Unit: 2623

wherein when referring to data stored in the storage means and detecting stored data having a data identifier corresponding to the icon inputted by the input means, the comparing means reads the data out of the storing means to the data reproducing means (e.g. retrieve program/segment having program/segment identifier associated with the selected icon, and the retrieved content is provided to the control circuitry or processing circuitry for reproducing and playing back on the display screen – see including, but are not limited to, figures 4-10, “988, figures 18a-21, paragraphs 0153-0157).

Regarding claim 6, Ellis further discloses wherein a data identifier to be accepted by the accepting means includes a partial data identifier for identifying partial data included in the data (i.e. program/segment title, program/segment identifier, etc. – see including, but are not limited to, paragraphs 0127, 0155, 0163), and when referring to the data stored in the storing means and detecting stored partial data having a partial data identifier corresponding to the icon inputted by the input means, the comparing means reads the partial data out of the storing means to the data reproducing means (e.g. storing means reads out requested episode/segment for playback – see including, but are not limited to, figures 4-10, paragraphs 0017, 0128-0129; “988, figures 18a-21, paragraphs 0153, 0157, 0177-0180).



Art Unit: 2623

Regarding claims 15-16, the claimed recording program for performing the process is broader in scope than the claimed recording devices in claims 1 and 3, and are analyzed as discussed in the rejections of claims 1 and 3.

Regarding claims 17-18, the limitations of the recording medium as claimed correspond to the limitations of the data recording program for performing the processes as claimed in claims 15-16, and are analyzed as discussed in the rejections of claims 15-16.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2005/0028208).

Regarding claim 7, the limitations of the performance recording system that correspond to the limitations of the data recording device in claim 1 are analyzed as discussed in the rejection of claim 1. For the additional limitation of portable device which is superior in carryability and capable of obtaining and storing a data identifier given to a

Art Unit: 2623

performance is met by remote access device (24) which may be any device suitable personal computer, portable computer, palmtop computer, handheld personal computer, display remote, touch screen remote, automobile PC, PDA or any other suitable computer based device and capable of obtaining and storing data identifier given to a performance such as title of a program, program identifier, etc.– paragraph 0092, figures 1, 5);

for the additional limitation “a distribution medium for distributing record data of the performance as data together with the data identifier” is met by distribution medium (18) for distributing program and program guide data and other information to the interactive program guide television equipment 17 – figure 1, paragraphs 0066-0069);

for the additional limitation “a data recording device which stores record data based on the data identifier from the portable device and the data identifier from the distribution medium” is met by storage device at television equipment 17 which store program/program segment/program guide data based on data identifier (program title, program identifier, etc.) from the remote access device (24) and the data identifier from the distribution medium (18 – see including, but are not limited to, figures 1, 2b, 3-5, paragraphs 0017, 0110, 0127, 0163).

Ellis further discloses remote access device (24) which may be any device suitable personal computer, portable computer, palmtop computer, handheld personal computer, display remote, touch screen remote, automobile PC, PDA or any other suitable computer based device and capable of obtaining and storing data identifier given to a

Art Unit: 2623

performance such as title of a program, program identifier, etc.— paragraph 0092, figures 1, 5) and the remote access device is capable of obtain and store a data identifier at any location (i.e. when a user is caught in traffic in an automobile – paragraph 0017). Since the remote access device is a portable unit as indicated above, it would have been obvious to one of ordinary skill in the art that the portable device (24) is capable of obtaining and storing a data identifier given to a performance at a performance site in order to at least improve accuracy of user desired data.

Regarding claims 8-12, the additional limitations as claimed correspond to the additional limitations as claimed in claims 2-6, and are analyzed as discussed with respect to the rejection of claims 2-6.

Regarding claim 13, Ellis further discloses the portable device is a mobile phone capable of receiving the data identifier which is transmitted by radio waves (paragraph 0092).

8. Claims 14, 19-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2005/0028208) in view of Sehr (US 6,999,936).

Regarding claim 14, Ellis discloses a recording system comprises a portable device as discussed in the rejection of claim 7. Ellis further discloses remote access device (24) which may be any device suitable personal computer, portable computer, palmtop

Art Unit: 2623

computer, handheld personal computer, display remote, touch screen remote, automobile PC, PDA or any other suitable computer based device and capable of obtaining and storing data identifier given to a performance such as title of a program, program identifier, etc.– paragraph 0092, figures 1, 5). However, Ellis does not specifically disclose the portable device is a card-type device.

Sehr discloses the portable device is a card type device (e.g. portable visitor card device) to which an identifier is magnetically or electronically writable (see including, but are not limited to, abstract, col. 2, line 46-col. 3, line 12; col. 3, lines 34-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellis to use the teaching as taught by Sehr in order to reduced administrative cost, improved productivity, better quality of service, and higher revenues associated with the issuance, usage, and processing of the computerized cards (col. 2, lines 2-40).

Regarding claim 19, the limitations as claimed that correspond to the limitations as claimed in claim 7 are analyzed as discussed with respect to the rejection of claim 7. However, Ellis does not specifically disclose the additional limitation of an entrance ticket for performance used as a portable device.

Sehr disclose an entrance ticket for performance used as a portable device (portable ticketing card/ portable visitor card device used for the admission to events such as

Art Unit: 2623

sporting activities or other entertainment programs- see including, but are not limited to, abstract, col. 3, lines 34-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellis to use the teaching as taught by Sehr in order to reduced administrative cost, improved productivity, better quality of service, and higher revenues associated with the issuance, usage, and processing of the computerized cards (col. 2, lines 2-40).

Regarding claims 20-24, the additional limitations as claimed correspond to the additional limitations as claimed in claims 8-12, and are analyzed as discussed with respect to the rejections of claims 8-12.

Regarding claim 25, Ellis in view of Sehr teaches a system as discussed in the rejection of claim 19. Ellis further discloses information storing means (i.e. storing device for previously storing program guide data in the television equipment 17) corresponding to partial data included in the data (see including, but are not limited to, paragraphs 0073, 0078, 0083, 0089);

reproducing means (control circuitry, processing circuitry, or producing device in program server) for producing the information stored in the information storing means (retrieve program guide data from the storage device and generate the program guide display screen using retrieved from guide data – see including, but are not limited to, paragraphs 0073, paragraph 0078, 0102).

Art Unit: 2623

Regarding claims 26-30, the additional limitations as claimed correspond to the additional limitation as claimed in claims 8-12, and are analyzed as discussed with respect to the rejections of claims 8-12.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gruse et al. (US 6,173,112) discloses method and system for recording in progress broadcast program.

Nemirofsky (US 5,594,493) discloses television signal activated interactive smart card system.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 9:00 - 6:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Son P. Huynh

August 2, 2006

  
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